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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Daniel R. Ahles

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EXAMINER

OYEBISI, OJO O

ART UNIT

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3695

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/041,714	<b>Applicant(s)</b> AHLES ET AL.	
	<b>Examiner</b> OJO O. OYEBISI	<b>Art Unit</b> 3695	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) ☒ Responsive to communication(s) filed on 12/17/09.

2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4) ☒ Claim(s) 1-29 and 38 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) ☐ Claim(s) 1-3, 7-10 is/are allowed.

6) ☒ Claim(s) 4-6, 11-29 and 38 is/are rejected.

7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.

8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☐ All    b) ☐ Some \*    c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☐ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.

4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.

5) ☐ Notice of Informal Patent Application

6) ☐ Other: \_\_\_\_\_.

### DETAILED ACTION

In the amendment filed on 12/17/09, the following have occurred: claim 7 has been amended and claims 1-29, and 38 are currently pending. By this amendment, the rejection of claim 7 under 35 USC 101 has been withdrawn. In the last office action, dated 05/11/2009, the examiner indicated that claims 1-6, 8-29, and 38 are allowed. However, after careful consideration and thorough review by a second pair of eyes, it was found that independent claims 4, 11, 24, and 38 are not allowable after all. Claims 1-3, 7, and 8-10 are still allowed.

#### *Claim Rejections - 35 USC §101*

1. 35 U.S.C. §101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claim 4 are rejected under 35 U.S.C. §101 because the claimed invention is directed to non-statutory subject matter.

3. Based on Supreme Court precedent (*Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)) and recent Federal Circuit decisions (*In re Bilski*), §101 process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing (the Supreme Court recognized that this

test is not necessarily fixed or permanent and may evolve with technological advances.

*Gottschalk v. Benson*, 409 U.S. 63, 71 (1972)).

4. If neither of these requirements is met by the claim(s), the claimed invention is not a patent eligible process under 35 U.S.C. §101.

5. In this particular case, regarding the first test, in performing the steps of the claimed subject matter in claim 4, there is no requirement that a machine be used, thus the claims are not considered sufficiently tied to another statutory class. Regarding the second test, since the claimed subject matter in claim 4 may be performed using only human intelligence; the steps do not sufficiently transform the underlying subject matter to be statutory. Thus, to qualify as a 101 statutory method, the claim should positively recite the other statutory class (the thing or product) to which it is tied and should sufficiently transform the underlying subject matter. The examiner further contends that claim 4 only describes a substitute check with no recitation of the any steps or structures. Appropriate correction is required.

#### ***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 4-6, 11-29 and 38 rejected under 35 U.S.C. 102(b) as being anticipated by Carney et al (Carney, hereinafter, US PAT: 5,890,141).

**Re claim 4.** Carney discloses a method comprising instructing a user to replace separator symbols within an original MICR format check identifier with replacement symbols, comprising numeric fields separated by the separator symbols, and the substitute check identifier comprising the numeric fields separated by the replacement symbols(see the abstract and fig.1).

**Re claims 5,6.** Carney further discloses the method further comprising instructing the user to enter the substitute check identifier with a computer keyboard (Carney discloses inputting MICR data, see fig.4 elements 510 and 530 which is obviously done by the use of a computer keyboard).

**Re claim 11, 12-23.** Carney discloses method of receiving a check identifier during a check transaction, the method comprising: receiving, via at least one processor, a substitute check identifier, the substitute check identifier comprising a routing number, an account number and a check number, the substitute check identifier further including at least one non-numeric keyboard replacement symbol wherein the at least one replacement symbol separates at least two of the routing number, the account number, and the check number, and wherein the at least one non-numeric replacement symbol substitutes for at least one original separator symbol within a MICR line; and processing, via the at least one processor, the substitute check identifier to identify at

least one of the routing number, the account number and the check number (see the abstract, summary of the invention and fig.1).

**Re claims 24.** Claim 24 recites similar limitations to claim 11 and thus rejected using the same art and rationale as in claim 11 supra.

**Re claims 25, 26-29.** Carney further discloses the method, wherein the user is a customer (see the abstract)

**Re claim 38.** Carney discloses a system for receiving a check identifier during a check transaction, the system comprising: a processing means for receiving a substitute check identifier, wherein the substitute check identifier comprises at least one non-numeric keyboard replacement symbol that replaces at least one original separator symbol within an original MICR format check identifier with at least one generic symbol wherein the non-numeric replacement symbol demarcates between at least two of an account number, a routing number, and a check number (see the abstract, the summary of the invention and fig.1)

### ***Response to Arguments***

Applicant's arguments with respect to claims 4-6, 11-29 and 38 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to OJO O. OYEBISI whose telephone number is (571)272-8298. The examiner can normally be reached on 8:30A.M-5:30P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Kyle can be reached on (571)272-8594. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/OJO O OYEBISI/  
Primary Examiner, Art Unit 3695